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**Datasheet for the decision
of 17 February 2011**

Case Number: T 2323/10 - 3.3.05

Application Number: 06701434.0

Publication Number: 1843985

IPC: C03C 15/02

Language of the proceedings: EN

Title of invention:

Process for polishing glass substrate

Applicant:

Asahi Glass Company, Limited

Opponent:

-

Headword:

Glass polishing/ASAHI

Relevant legal provisions:

EPC R. 100(1), 103(1)(a), 111(2), 137(3)

Relevant legal provisions (EPC 1973):

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Keyword:

"Substantial procedural violation: absence of reasoning"

Decisions cited:

T 0278/00, T 0897/03, T 1356/05

Catchword:

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Case Number: T 2323/10 - 3.3.05

D E C I S I O N
of the Technical Board of Appeal 3.3.05
of 17 February 2011

Appellant: Asahi Glass Company, Limited
12-1, Yurakucho 1-chome
Chiyoda-ku
Tokyo 100-8405 (JP)

Representative: Müller-Boré & Partner
Patentanwälte
Grafinger Straße 2
D-81671 München (DE)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 14 October 2010
refusing European patent application
No. 06701434.0 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman: G. Raths
Members: J.-M. Schwaller
C. Vallet

Summary of Facts and Submissions

I. The appeal is directed against the decision of the examining division dated 14 October 2010 to refuse European patent application No. 06 701 434.0 relating to a "process for polishing glass substrate".

II. The grounds of the contested decision read as follows:

"In the communication(s) dated 22.09.2008, 20.05.2010 the applicant was informed that the application does not meet the requirements of the European Patent Convention. The applicant was also informed of the reasons therein.

The applicant filed no comments or amendments in reply to the latest communication but requested a decision according to the state of the file by a letter received in due time on 31.08.2010.

The European patent application must therefore be refused on the basis of Article 97(2) EPC."

III. The appellant lodged an appeal against this decision on 09 November 2010 and paid the prescribed fee on 11 November 2010. A statement setting out the grounds of appeal was filed on 14 January 2011.

IV. The appellant requests that the contested decision be set aside and that the case be remitted to the first instance with the order to grant a patent on the basis of claims 1 to 8 filed on 14 July 2010.

It also requested oral proceedings as an auxiliary measure.

V. The appellant's arguments can be summarised as follows:

The contested decision did not provide any grounds with respect to the last submission of 14 July 2010 where further arguments were provided regarding inventive step, including a new set of claims and Figures 1 and 2. This was not in accordance with the Guidelines for Examination which state that full reasons must be given in the decision refusing a patent application (Guidelines, Part C, Chapter VI, item 7.6).

The present invention was based on the findings that by measuring the width of waviness and carrying out a CGIB (i.e. gas cluster ion beam) etching with a beam size of at most the width of waviness, the waviness disappeared.

In document D1 the surface profile of glass substrate was measured in order to determine the timing of stopping an ion beam processing, but the beam conditions of dry etching were not determined according to measurements results of the surface profile.

Document D2 simply disclosed that the typical beam size was 1 cm in diameter, but was silent as to measuring the width of waviness and use of a beam having a size selected according to the width of waviness.

Therefore the subject-matter of claims 1 to 8 according to the claims at issue was novel and inventive in view

of the prior art documents D1 or D2, when taken alone or in combination.

Reasons for the Decision

1. The appeal meets the requirements of Articles 106 to 108 and Rule 99 EPC and is therefore admissible.

2. The purpose of an appeal procedure is mainly to give a party adversely affected by a decision of the first instance the possibility of challenging this decision on its merits. In order for a party to be able to examine whether a decision is justified or not, decisions open to appeal shall be reasoned. This principle, stated in Rule 111(2) EPC, is of major importance for ensuring the fairness of the procedure. Pursuant to the established jurisprudence of the Boards of Appeal, a reasoned decision must contain the grounds upon which the decision is based and all decisive considerations in respect of the legal and factual aspects of the case in file (T 278/00 OJ 2003, 546, in particular points 3. (second paragraph), 4.2 (last sentence) and 5. of the reasons; T 897/03, in particular points 3., 4. and 5. of the reasons; T 1356/05, in particular points 17. and 18. of the reasons).

3. In the present case, the contested decision neither specifies the grounds upon which it is based nor contains any facts or arguments that justify the refusal of the patent application.

The appealed decision solely contains a reference to reasons given in the communications of 22 September

2008 and 20 May 2010 that the examining division issued during the examination procedure. This sole reference however does not allow the reader to clearly and completely understand the reasons as to why the application is not considered allowable, in particular in view of the applicant's - now appellant - last submissions dated 14 July 2010 which constitute a reply to the first instance communication dated 20 May 2010.

4. The contested decision is thus clearly wrong in stating that "*the applicant filed no comments or amendments in reply to the latest communication ...*".

The board notes that it may be that the applicant's last submissions would not have led to a decision of the first instance differing from the view expressed in the communications, but in the present case, it was at least necessary to assess on the one hand whether the change in wording in claim 2 overcame the objection based on Article 84 EPC and, on the other hand, why the newly filed figures had not been taken into account in the assessment of inventive step.

5. In this context the appellant did not know, when filing the notice of appeal, whether the decisive ground for refusing the application was lack of clarity or lack of inventive step. As regards in particular the latter ground, the appellant furthermore did not know which document the first instance considered as representing the closest prior art, since the first communication referred to D1 and the second to D2 as the starting point for assessing inventive step.

6. In its letter dated 31 August 2010, the appellant withdrew its request for oral proceedings before the first instance and requested a decision according to the state of the file, but in any case, this request cannot be interpreted as the renouncement of a reasoned decision from the examining division.
7. The decision under appeal must therefore be set aside due to the lack of reasoning required by Rule 111(2) EPC, which amounts to a substantial procedural violation.
8. Pursuant to Rule 103(1)(a) EPC, the appeal fee shall be reimbursed where the board of appeal deems an appeal to be allowable, if such reimbursement is equitable by reason of a substantial procedural violation.

In the present case, as explained above, the absence of reasoning in the contested decision amounts to a substantial procedural violation. The appeal fee has therefore to be reimbursed.

9. Since the decision must be set aside, there is no need to hold oral proceedings before the board.
10. Exercising its discretion under Rule 137(3) EPC, which is applicable by virtue of Rule 100(1) EPC, the Board has decided to admit the set of claims filed on 14 July 2010 into the proceedings and to remit the case to the first instance for further prosecution on that basis.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution on the basis of claims 1 to 8 filed on 14 July 2010.
- 3 The appeal fee is to be reimbursed.

The Registrar:

The Chairman:

C. Vodz

G. Rath